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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 09/474,326 | 12/29/1999 | THOMAS J. FOTH | E-977 | 2120 |

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| EXAMINER |
|---|
| BACKER, FIRMIN |

| ART UNIT | PAPER NUMBER |
|---|---|
| 3621 | |

DATE MAILED: 07/01/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 09/474,326 | FOTH ET AL. | |
| | Examiner | Art Unit | |
| | Firmin Backer | 3621 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *05 May 2003* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1-8* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-8* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

***Response to Amendment***

This is in response to an amendment file on June 6th, 2003 for letter for patent filed on December 29th, 1999 in which claims 1-8 were presented for examination. In the amendment, no claim has been amended. Claims 1-8 remain pending in the letter.

***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1 – 3 and 8 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In claim 1, it is stated that the computer is used "... for reading the downloaded header and displaying...information... while concurrently downloading the encoded digital content product into the computer". However, on page 9, lines 16 – 18, of the specification it is stated that "the *remainder* of the file are respectively downloaded only if the buyer chooses to view the product preview... or buy the digital content item." (emphasis added) Further, on page 17, lines 9 – 14, it is stated that the encrypted digital content is being decrypted concurrently with being downloaded to the browser for display. Hence, it does not appear that the downloading of the header and displaying information is disclosed as occurring "while concurrently downloading the encoded digital content product into the computer", but

rather that while the encoded digital product is being downloaded it is concurrently being decrypted. Applicants are respectfully requested to indicate where in the disclosure the language of claim 1 is described.

Also, it is not clear from the specification as to where there is disclosure for "downloading into the computer... information related to purchasing a digital content product and the digital content product in encoded form"; i.e., on page 9, as indicated above, it appears that only a part of the digital content product is downloaded.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claim 1 is rejected under 35 U.S.C. 102(e) as being anticipated by Downs et al.

Regarding claim 1:

Applicants' step of downloading a digital content file including a header (information related to purchasing a digital content product) and the digital content product in encoded form reads on the digital content-related data or metadata (header), SC(s) element 641, Applicants' digital content product reads on content 113, Applicants' merchant reads on figure 6, elements 101, 111, and 103, see also column 69, lines 22 – 24, Applicants' digital content product in

encoded form reads on the storage of the content 113 at a content hosting site, element 111, and Applicants' step of using the computer for reading reads on the SC(s), element 641, column 75, lines 11 – 20.

Regarding claim 4:

Applicants' step of inputting reads on the filename of the content input to a queue by the computer of the operator of the workflow manager, element 154, the web site location reads on the path and filename of the digital content, column 51, lines 24 – 39, Applicants' step of connecting to the web site reads on the remote access capability of the operator of the workflow manager, column 49, lines 11 – 22, and Applicants' step of storing the content reads on the digital content stored at the Content Provider, element 101 and columns 8 and 9, lines 48 – 53 and lines 48 – 55, respectively.

Regarding claim 5:

Applicants' step of inputting into the computer a location reads on the inherent input to the computer of the "target destination", column 66, lines 53 - 57.

Regarding claim 6:

Applicants' product file reads on the Content SC(s), element 630 and column 28, lines 7 – 9.

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

9. Claims 2, 3, 8 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Downs et al.

Applicants' step of inputting a request to purchase reads on column 75, lines 20 – 24 and element 105 (broker computer), and Applicants' step of receiving a key for decoding, from the clearinghouse (broker), reads on element 623 and column 77, lines 33 – 40.

Although Downs et al teach that the content 113 is first decoded at the end user (computer) with one key, element 623, then re-encrypted with a SEAL key for ultimate storage at the end user, Downs et al do teach that the SEAL encrypted content can be concurrently played (displayed) while it is being decoded. See column 82, lines 51 – 55. Therefore, it is considered that it would have been obvious to one of ordinary skill in the art at the time of the invention to perform decoding and playing concurrently, based on the first key as a matter of design preference, rather than re-encrypting the content with a different second key and then concurrently decoding and playing if utilizing a second key (SEAL key) is not a requirement for proper security of the content at the end user device as again, the technology of concurrently decoding and playing is taught by Downs et al.

Regarding claim 9:

Although Downs et al do not teach storing the content unencrypted, it is considered that it would have been obvious to one of ordinary skill in the art at the time of the invention to store content in an unencrypted form as a matter of preference; i.e., if security is not an issue at the place of storage. Also, it is considered old and well known that by storing unencrypted data, that

the data will require less processing time if it is necessary to obtain the data quickly while within the place of content storage, prior to its transmission.

***Response to Arguments***

Applicant's arguments filed May 6th, have been fully considered but they are not persuasive.

a. Applicant argues that the USC112 2nd, rejection of claim 1 is improper since the subject matter clearly support by the specification. Examiner respectfully disagrees with applicant characterization of the specification. Upon further of the specification, examiner concluded that the claim language in the Applicant's inventive concept is not fully supported and the interpretation of *concurrent* cannot be found in the specification. Therefore, claim 1 stands rejected under the USC 112 2nd, paragraph. Applicant further argues that the prior art fail to teach an inventive concept of a remote computer actuated encryption of designated files. Examiner respectfully disagrees with applicant characterization of the prior art. Downs clearly teach a method and apparatus to securely providing data to a user's system. The data is encrypted so as to only be decryptable by a data decrypting key, the data decrypting key being encrypted using a first public key, and the encrypted data being accessible to the user's system, the method comprising transferring the encrypted data decrypting key to a clearing house that possesses a first private key, which corresponds to the first public key; decrypting the data decrypting key using the first private key; re-encrypting the data decrypting key using ia second public

key; transferring the re-encrypted data decrypting key to the user's system, the user's system possessing a second private key, which corresponds to the second public key; and decrypting the re-encrypted data decrypting key using the second private key. Applicant Also argues that the prior art fail to teach an inventive concept of concurrently downloading. Examiner respectfully disagrees with applicant since such concept is not clearly describe in the specification. Claims 1-8 stand rejected.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Firmin Backer whose telephone number is (703) 305-0624. The examiner can normally be reached on Mon-Thu 8:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on (703) 305-9768. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7687 for regular communications and (703) 305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

Firmin Backer
Examiner
Art Unit 3621

JOHN W. HAYES
PRIMARY EXAMINER

June 25, 2003